REMARKS

The following Remarks are submitted in response to the Office Action issued on June 21, 2004 (Paper No. 16) in connection with the above-identified patent application, and are being filed within the three-month shortened statutory period set for a response by the Office Action.

Preliminarily, Applicants respectfully note that the Examiner's statement of the status of the claims of the application on the coversheet of the Office Action is incorrect. In particular, the claims noted as being withdrawn from consideration were in fact previously canceled, leaving the remainder of claims 10-163 pending in the present application.

Claims 106-115, 117-119, 122-138, 140-142, 145-158, 162, and 163 are pending in the present application, and stand rejected. Applicants respectfully request reconsideration and withdrawal of the rejection of the claims consistent with the following.

The Examiner has rejected independent claims 106, 129, and 152 under 35 USC § 101 as being non-statutory for the reason that such claims "contain abstract idea" [sic]. Applicants respectfully traverse the section 101 rejection.

According to the Examiner, although the claims "contain computer-per-se materials" [sic], the "claimed 'virtual' DRM system has all 'virtual' structural components" [sic] that are merely computer instructions. However, and significantly, the DRM system recited in the claims of the present application is not recited as being 'virtual', and Applicants respectfully submit that the Examiner is improperly reading such term into the claims when such term is in fact clearly not present in the recited claims.

Moreover, and at any rate, Applicants respectfully submit that the federal courts have repeatedly concluded that section 101 requires only the recitation of a concrete

element such as a computer in order for an apparatus claim (such as claim 106 - "A digital rights management (DRM) system operating on a computing device . . . "; claim 129 – "A computing device having a digital rights management (DRM) system operating thereon . . . "; and claim 152 - "A computer-readable medium having computer-executable instructions stored thereon . . . "), to be statutory under section 101. Further, the Guidelines for Examining Computer-Related Inventions as set forth by the US Patent and Trademark Office in essence require no more. Such computer or the like need only be recited somewhere in the claim, not necessarily in the body thereof, as the Examiner appears to believe.

Accordingly, and for all of the aforementioned reasons, Applicants respectfully submit that the independent claims of the present application do in fat recite statutory subject matter. As a result, Applicants respectfully request reconsideration and withdrawal of the section 101 rejection.

The Examiner has again rejected claims 106-109 under 35 USC § 103(a) as being obvious over Stefik (U.S. Patent No. 5,715,403). In addition, the Examiner appears to reject similar claims from the claim set headed by independent claim 129 ('the 129 claim set') and similar claims from the claim set headed by independent claim 152 ('the 152 claim set'). Applicants respectfully traverse this first § 103(a) rejection.

Applicants respectfully submit that the first section 103(a) rejection is prima facie improper for the reason that the Examiner has not particularly pointed out how the Stefik reference is to be applied to make obvious claim 106 (and by extension claims 129 and 152). In particular, the Examiner merely states that the Stefik reference discloses particular elements recited in claim 106, all apparently at column 2, lines 21-43 inasmuch as no other citations to specific parts of the Stefik reference are provided, and then states that "Although

Stefik does not expressly disclose exact words as claimed; it would be obvious . . . to implement [the Stefik reference] to perform such specific functions . . . " [sic]. Applicants submit that such a broad rationale without any more detail cannot and should not be the basis for the section 103(a) rejection, especially inasmuch as such broad rationale does not represent anything more than wishful thinking on the part of the Examiner.

Applicants respectfully submit that such a broad rationale is nothing more than a blanket statement on the part of the Examiner without any real substance, and that such a blanket statement cannot satisfy the requirement that the Examiner make a prima facie case of obviousness under Section 103(a). In particular, Applicants respectfully point out that such blanket statement amount to a blanket rejection of the claims without providing any specific details. Moreover, such blanket statement does not at all provide any indication of why the cited Stefik reference should or could be applied to make obvious the invention recited in claim 106 (and claims 129 and 152).

That said, Applicants again point out that independent claim 106 recites a digital rights management (DRM) system operating on a computing device when a user requests that a protected piece of digital content be rendered by the computer device in a particular manner. In the system, a license store stores one or more digital licenses on the computing device. A license evaluator determines whether any licenses stored in the license store correspond to the requested digital content, determines whether any such corresponding licenses are valid, reviews license rules in each such valid license, and determines based on such reviewed license rules whether such license enables the requesting user to render the requested digital content in the manner sought. Finally, a state store maintains state

information corresponding to each license in the license store. The state information is created and updated by the license evaluator as necessary.

In addition, claim 106 recites a black box that performs encryption and decryption functions as part of the evaluation of any license. In claim 106, the license evaluator selects an enabling, valid license and works with the black box to obtain a decryption key (KD) from the selected license, and the black box employs such decryption key (KD) to decrypt the protected digital content. In particular, the black box decrypts the protected digital content when the license evaluator determines that a license in fact enables the requesting user to render the requested digital content in the manner sought.

Independent claim 129 recites subject matter similar to that in independent claim 106, but in the form of a computer with the DRM system operating thereon. Independent claim 152 also recites subject matter similar to that in independent claim 106, but in the form of a computer-readable medium with computer-executable instructions thereon for performing a method.

The Stefik reference discloses a system for controlling use and distribution of digital works. The system is exemplified by multiple repositories wherein the digital works are stored and accessed from such repositories, and are transferred only between such repositories. Each repository is a trusted system and can operate in a requestor mode for requesting a digital work from another repository and a server mode for responding to a request from another repository. Importantly, and as disclosed beginning at column 9, line 20, usage rights (i.e., a license with license terms) are attached to digital works in the Stefik system, and both the work and its attached license are transmitted from a serving repository (at a content provider, e.g.) to a requesting repository (at a client, e.g.). See also Fig. 1 and

column 7, lines 16-48. Accordingly, the Stefik reference does not disclose or suggest a license store for storing one or more licenses on a Stefik computing device, as is required by claims 106, 129, and 152, inasmuch as a Stefik license is attached to each Stefik digital work. Put another way, because each Stefik work has a license attached thereto, there is no need in the Stefik system for a license store that would store such license.

Moreover, since no license store is present in the Stefik system, the Stefik reference does not disclose or suggest a license evaluator that determines whether any licenses stored in such a license store correspond to requested digital content, as is required by claims 106, 129, and 152. Also, since in the Stefik system a work is accessed only in accordance with the terms of the attached license, the Stefik reference does not disclose or suggest that such a license evaluator should or could determine from among multiple licenses in a license store whether any of such multiple licenses correspond to the requested digital content, as is also required by claims 106, 129, and 152.

Further, and as explained in the Stefik reference at Column 10, line 35 – Column 11, line 25, the attached Stefik license is embodied as a rights portion 704, where each right includes a right code field 1001 and a status information field 1002 that contains information relating to a state of the right. As shown in referenced Table 1, such state may be described based on information including a time until expiration, a copy count, etc. Significantly, because the state information for each Stefik work / license is maintained with such work / license, such state information is not separate from such work / license and therefore is not available to be stored in any state store, as is required by claims 106, 129, and 152. Accordingly, the Stefik reference does not disclose or suggest a state store for maintaining state information corresponding to each license in any license store, as is

required by claims 106, 129, and 152. Put another way, because each Stefik work has state information attached thereto, there is no need in the Stefik system for a state store that would store such state information.

At any rate, the Stefik reference does not disclose a black box that performs encryption and decryption functions as part of the evaluation of any license, where the license evaluator selects an enabling, valid license and works with the black box to obtain a decryption key (KD) from the selected license, and the black box employs such decryption key (KD) to decrypt the protected digital content, all as required by claims 106, 129, and 152. Also, the Stefik reference does not disclose that such a black box decrypts the protected digital content when the license evaluator determines that a license in fact enables the requesting user to render the requested digital content in the manner sought, as is also required by claims 106, 129, and 152.

Thus, Applicants respectfully submit that the Stefik reference does not make obvious independent claims 106, 129, or 152, or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the first § 103(a) rejection.

The Examiner has now rejected claim 106 under 35 USC § 103(a) as being obvious over Downs et al. (U.S. Patent No. 6,226,618) in view of the Stefik reference. In addition, the Examiner appears to reject similar claims from the 129 and 152 claim sets. Applicants respectfully traverse this second § 103(a) rejection.

Briefly, according to the Examiner, the Downs reference teaches the recited invention except for a state store which is disclosed in the Stefik reference. However, and

again, the Stefik reference does not disclose such a state store and would not in fact disclose such a state store for the reason that all state information in the Stefik system is maintained with each work / license and not in some centralized location such as the state store of the present invention, where such state information would be separate from such work / license, as is required by claims 106, 129, and 152. Accordingly, the combination of the Downs and Stefik references do not disclose or suggest a state store for maintaining state information corresponding to each license in any license store, as is required by claims 106, 129, and 152.

Thus, Applicants respectfully submit that the combination of the Downs and Stefik references does not make obvious independent claims 106, 129, or 152, or any claims depending therefrom. Instead, Applicants respectfully submit that such claims are not in fact obvious in view of the cited references, and accordingly, Applicants respectfully request reconsideration and withdrawal of the second § 103(a) rejection.

The Examiner has also again rejected claims 110-112 (and perhaps claims 114, 119, 123, 124, 126, 127, and 128) under 35 USC § 103(a) as being obvious over the Stefik reference in view of Krishnan (U.S. Patent No. 6,073,124); claims 113-115 under 35 USC § 103(a) as being obvious over the Stefik reference in view of the Krishnan reference and further in view of Ginter (U.S. Patent No. 5,892,900); and claims 117-119 and 122-128 (claim 121 having already been canceled) under 35 USC § 103(a) as being obvious over the Stefik reference in view of the Krishnan reference and further in view of the Ginter reference. In addition, the Examiner appears to reject similar claims from the 129 and 152 claim sets. Applicants respectfully traverse these additional § 103(a) rejections.

Applicants respectfully submit that since independent claims 106, 129, and 152 are unanticipated and have been shown to be non-obvious, then so too must all claims

depending therefrom be unanticipated and non-obvious, including the aforementioned claims, at least by their dependency. Accordingly, Applicants respectfully request reconsideration and withdrawal of the additional § 103(a) rejections.

In view of the foregoing discussion, Applicants respectfully submit that the present application is in condition for allowance, and such action is respectfully requested.

Respectfully Submitted,

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